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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,544	07/16/2003	Ruediger Tueshaus	Dorstener-002	8429

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EXAMINER

SPERTY, ARDEN B

ART UNIT PAPER NUMBER

1771

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/620,544

Applicant(s)

TUESHAUS ET AL.

Examiner

Arden B. Sperty

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-23 and 42-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-23, 42-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/24/06</u> . | 6) <input type="checkbox"/> Other: _____ |

NON-FINAL OFFICE ACTION

1. Applicant's Request for Continued Examination (RCE) has been entered, and the amendments and remarks carefully considered.

Claim Rejections - 35 USC § 112

2. Applicant's evidence and comments in support of a wire mesh which still has the ability to block light, is persuasive. Applicant's explanation and evidence of the term "wire mesh" in the industry is found persuasive. The rejection of claims 5, 16-20, 42-44 and 46-47 under 35 USC 112, second paragraph, stated on pages 2-3 of the Final Office Action of January 23, 2006, is withdrawn.

Applicant's amendment to remove the "or substantially zero" language renders moot the rejection of claims 5, 16-20, 42-44, and 46-47, under 35 USC 112, second paragraph, stated on page 3 of the Final Office Action.

Applicant's amendment to replace the term "permits" with the term "controls" is sufficient to overcome the inconsistencies rejected in the Final Office Action. The rejection of claims 5, 16-20, 42-44, and 46-47, stated on page 3 of the Final Office Action, is withdrawn.

Applicant's amendment to claim 6 renders moot the rejection under 35 USC 112, second paragraph, stated on pages 3-4 of the Final Office Action. All objectionable language has been removed, therefore the rejection is withdrawn.

Art Unit: 1771

Applicant's evidence and comments regarding a heddle weave are sufficient to overcome the rejection of claims 14 and 15, under 35 USC 112, second paragraph, stated on page 4 of the Final Office Action.

The examiner rejected claim 21, under 35 USC 112, second paragraph, because the flexibility and bendability required to provide the claimed property were unclear. Applicant's comments and evidence regarding plasticity are sufficient to warrant withdrawal of the rejection. The terms are still interpreted as relative, meaning that a degree of flexibility and bendability are implied, but a specific value or range is not.

Claim 21 remains rejected under 35 USC 112, first paragraph, as stated in the Final Office Action. Applicant is not enabled for every non-glass material. Applicant is enabled for the materials in the specification, thus the claim should be amended to be commensurate.

3. Claim 5 is herein rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification. While the specification does reference a filter material, the referenced filter material is not employed as claimed. The filter material mentioned in the specification is used for filtering particles; a "filter" is never discussed in the specification as being within one or more transparent materials and for filtering light. It appears that Applicant's motivation for the amendment was to clarify the claimed "wire mesh," because the term was rejected under 35 USC 112, second paragraph, as being indefinite. As stated above, the rejection is withdrawn per

Art Unit: 1771

Applicant's evidence and comments regarding industry standards. Thus, the amendment to require a "filter material" is unnecessary.

4. Amended claim 6 is herein rejected under 35 USC 112, first paragraph.

Regarding claim 6, Applicant is not enabled for the sole exclusion of chicken wire. The specification does not provide basis for the amendment. While there is nothing inherently ambiguous or uncertain about a negative limitation, the boundaries of the patent protection sought must be set forth definitely, albeit negatively, in the specification. The mere absence of a positive recitation is not basis for an exclusion. See MPEP 2173.05(i). Applicant is currently claiming an exclusion, without a teaching of any such exclusion.

Claim Rejections - 35 USC § 102/103

5. Claims 5-7, 9, 11-12, 21-22, are rejected under 35 U.S.C. 102(b), as being anticipated by, or in the alternative, under 35 USC 103(a) as obvious in view of, US Patent 5998028 to Eckart et al.

The reference teaches a thermoplastic article which is a laminate comprising upper and lower sheet materials, with metallic wire, rods, or bars therebetween (col. 1, lines 11-22). The product may have varying degrees of transparency (col. 1, lines 38-40). The metallic element may be a transparent metal mesh fabric, screen, or open mesh, and may be woven, welded, knitted, or fabricated by other means (col. 3, lines

Art Unit: 1771

11-18). The metallic filaments, rods or bars may have varying cross-sectional diameters and/or colors, and may be made from a variety of metals (col. 3, lines 16-30).

Although Eckart does not explicitly teach one side of the metallic mesh or screen is more reflective than the other side, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e., woven wire mesh with transparent sheet material). The burden is upon the Applicant to prove otherwise. In re Fitzgerald, 205 USPQ 495. In the alternative, the claimed reflectiveness would obviously have been provided by the process disclosed by Eckart. Note In re Best, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102.

Regarding claim 6, chicken wire is not required by the prior art.

Regarding claim 7, the reference teaches adhesives (col. 4, lines 41-44).

Regarding claim 9, planar wires, rods, or bars, are recited (col. 3, line 24).

The limitations of claims 11 and 12 are met due to the similar intended uses of the prior art (col. 3, lines 31-36; col. 6, lines 15-29).

The thermoplastic article of the prior art meets the limitations of claim 21 because it is formable (col. 6, lines 14+).

Claim Rejections - 35 USC § 103

6. Claims 8, 10, 13-20, 23, and 42-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5998028 to Eckhart, as applied to claim 5 above.

Regarding claims 8 and 42-47, the reference teaches varying cross-sectional areas and geometries (col. 3, lines 21-30). Although triangular cross-sections are not specified in the listed exemplary cross-sections, it would have been obvious for one of ordinary skill in the art to select a desired cross-section based on the ultimate intended effect. The same applies to the limitations of claim 10, and the twisting limitations of claims 23, and 42; it would have been obvious for one of ordinary skill in the art to select elements based on the ultimate, predictable, intended effect. The plurality of variables presented in column 3, lines 11-35 support the intent for one of ordinary skill in the art to design the decorative product as desired. Absent a showing of unexpected results, not just aesthetic preference, the selection of decorative modifications would have been obvious to one of ordinary skill or creativity in the art. A known type of woven or knitted mesh would also have been selected based on the ultimate, predictable, intended effect. The weaves of claims 13-16 are known in the art, per Applicant's admission, and therefore would have been obvious in view of the ultimate intended effect.

Regarding claims 17-20, it is the intention of the prior art for one of ordinary skill in the art to select preferred metallic elements (col. 3, lines 24-30), and the amount of light transmission would be a property of the diameter, shape, and weave/knit of elements selected for the mesh. Absent a showing of unexpected results, not just aesthetic preference, it would have been obvious to one of ordinary skill in the art to select a mesh with desired light transmission properties.

Response to Arguments

7. Applicant's arguments, filed 5/23/06, regarding the prior art rejections have been fully considered but they are not persuasive. Applicant argues that Eckart does not meet the claim limitations under 35 USC 102(b), or in the alternative, under 35 USC 103(a).

The examiner remains of the position that the variable materials and fabrication methods taught by Eckart inherently provide for a material that is not identical on both sides. For example, it is common for one face of a woven material to have a different appearance than the opposite face. The same applies to a welded material wherein all welds are on one face of the material. The claim language so broadly claims the relative difference in reflectivity that effectively any minor difference in reflectivity meets the claim limitations. It is reasonable to presume that the variable materials and fabrication methods taught by Eckart contribute to some difference in reflectivity. Applicant has not proven otherwise, therefore the rejection remains.

8. Additionally, the prior art meets the structural and chemical features of the claimed wire mesh and thus, the reflective properties must be met. Like materials cannot have mutually exclusive properties. If applicant treats the one side or otherwise changes the chemistry or structure of the side to be more reflective, the claims do not reflect this and could be considered indefinite for not claiming the invention.

9. Regarding claim 9, Applicant states on page 13 that the claimed weave is unusual. The argument is not factual, and Applicant has not shown unexpected results with the claimed weave. Furthermore, Eckart need not recognize or appreciate the same qualities as Applicant for the qualities to be present.

Art Unit: 1771

Applicant argues, on pages 14-15 of the response, that the listed claims are not obvious in view of Eckart. Applicant argues that triangular wire is not common, and thus would not be obvious to one of ordinary skill in the art. However, the reference clearly provides for varying cross-sectional shapes, and Applicant has not shown any unexpected results using triangular wire. Similarly, Applicant has yet to show factual evidence of unexpected results due to the other obvious features recited in said claims including cross-sectional shape, twist or weave of the wires.

Conclusion

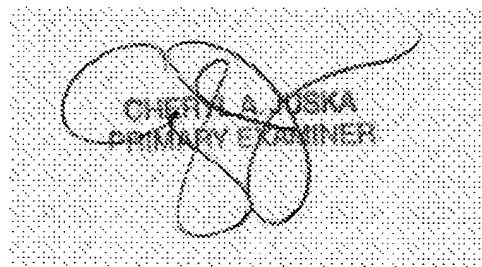
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arden B. Sperty whose telephone number is (571)272-1543. The examiner can normally be reached on M-Th, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571)272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1771

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Arden B. Sperty
Examiner
Art Unit 1771



July 17, 2006